## THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today

- (1) was not written for publication in a law journal and
- (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WILLIAM P. SCHMIDT and FRANKLIN D. HUTCHINSON

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Appeal No. 96-1419 Application 08/081,971

ON BRIEF

Before CALVERT, <u>Administrative Patent Judge</u>, McCANDLISH, <u>Senior Administrative Patent Judge</u> and FRANKFORT, <u>Administrative Patent Judge</u>.

McCANDLISH, Senior Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 9 and 12. No other claims are

<sup>&</sup>lt;sup>1</sup> Application for patent filed June 23, 1993. According to appellants, this application is a continuation-in-part of Application 07/843,508, filed February 28, 1992, now U.S. Patent No. 5,301,916, issued April 12, 1994, which is a continuation-in-part of Application 07/419,213, filed October 10, 1989, now U.S. Patent No. 5,106,049, issued April 21, 1992.

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pending in the application.

Appellants' invention relates to a mirror-mounting bracket adapted to be secured to the side door of a vehicle over a wing window opening in the door. Appellants' specification describes the bracket as including not only the unitary bracket part (18, 20) or base member, as it is called in appealed claim 8, per se, but also the means for fastening the base member to the door, namely the fastening bolts (78), the nuts (80) and the mounting plate (76). Although not expressly described in appellants' specification, it appears that the wing window of the vehicle door must be removed in order to mount the bracket on the door in the embodiment in which the mounting plate is disposed on the interior side of the door, thus requiring the fastening bolts to extend through the wing window opening and through apertures in the mounting plate to secure the plate to the base member which lies on the exterior side of the door.

The base member of the bracket is defined as having a first portion or member (18) and a second portion or member (20) which are joined to each other by a hinge (70) to permit the second portion to be pivoted from a closed position (see Figure 5 of the drawings) to an opened position (see Figure 4 of the drawings) to

enable a mirror support rod (26) to be positioned in a bore (68) between two bore-defining clamping portions of the base member.

Independent claim 1 is directed to a vehicular mirror mounting bracket, independent claim 8 is directed to a mirror apparatus and independent claim 12, the only other independent claim on appeal, is directed to a mirror mounting assembly.

Appealed claims 1 and 12 are limited to elements of the bracket itself whereas appealed claim 8 recites the combination of the bracket, the support rod and the mirror attached to the support rod.

In appealed claim 1, appellants have chosen to recite in the present tense that each of the two mounting surfaces of the bracket "abuts against and overlies a portion of the vehicle" rather than merely reciting that the mounting surfaces are adapted to abut and overlie a portion of the vehicle. In claim 12, the mounting plate is recited as actually "being mounted inside the passenger compartment" rather than merely reciting that the mounting plate is adapted to mounted inside the passenger compartment. As such, claims 1 and 12 define the invention as if the bracket is mounted in place on the vehicle

door. Based on this interpretation, claim 1 and dependent claims

2 through 7 and 9 are therefore limited to a mirror-mounting

bracket installed in place on the vehicle door, and claim 12 is

likewise limited to a mounting assembly installed in place on the

vehicle door. Any other interpretation would raise a question of indefiniteness under the second paragraph of 35 U.S.C. § 112.

Certain informalities in appealed claims 1, 2, 4, 8 and 12 are deserving of interpretation and of correction in the event of further prosecution before the examiner. A discussion of these informalities follows.

In appealed claim 1, the recitation in clauses (a) (1) and (b) (3) of "the winged window," lacks strict antecedent basis and is interpreted to refer back to the recitation of "a wing window opening" in the preamble of the claim. In clause (b) (2) of claim 1, the recitation of "the portions" is interpreted to refer back the claimed clamping portions.

In appealed claim 2, the recitation of "the base member," which also lacks antecedent basis, is interpreted to refer back to the combination of the claimed first and second members in light of the language in claim 8.

In appealed claim 4, the recitation of "fasteners deployed within the slots of the base member" is interpreted to refer to the slots in the claimed first and second members inasmuch as there is no recitation that the base member has any slots.

In appealed claim 12, the inaccurate recitation in the preamble that the mounting assembly is "for mounting at least one

mirror on a support rod" is interpreted to mean that the mounting assembly is for mounting a support rod carrying at least one mirror. In clause (a) of claim 12 the recitation of the support rod "being received into the bore" as if the rod were a part of the claimed mounting assembly is interpreted to mean that the bore is adapted to receive the support rod. In clause (b) of claim 12, the recitation of "the wing window," which lacks strict antecedent basis, is interpreted to refer back to the recitation of the "wing window opening" in the preamble of the claim.

In appealed claim 8, the recitation of "the support" in clause (c) (1) (iii) lacks strict antecedent basis and is interpreted to read on the support rod recited in clause (b). In addition, each occurrence of the phrase "accurate surface" in clause (1) was evidently intended to refer to an arcuate surface.

Other problems noted in appealed claims 8 and 9 are discussed infra in our new ground of rejection introduced under 37 CFR
§ 1.196(b).

A copy of the appealed claims, as these claims appear in the appendix to appellants' brief, is appended to this decision.

The following references are relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) and obviousness under 35 U.S.C. § 103:

Schuplin Seckerson, deceased et al.	3,802,655 3,807,675	Apr. Apr.		1974 1974
(Seckerson) Schmidt et al.	4,500,063	_		1985
<pre>(Schmidt) Williams et al. (Williams)</pre>	4,518,191	May	21,	1985

Claims 1 through 7 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schuplin, claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Schmidt in view of Schuplin and further in view of Seckerson or Williams, claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Schuplin in view of Seckerson or Williams, and claim 12 additionally stands rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

With regard to the rejection of claim 12 under the second

paragraph of § 112, the examiner's position is as follows:

Appellant's recitation that "the mounting plate being larger in area than the wing window" is generally vague as such language is inconsistent with the preamble which sets forth a "mirror mounting assembly" intended for mounting on a wing window. The wing window is not part of the claimed article (e.g. mirror assembly); and to define a limitation of the claimed article (e.g. the mounting plate of the mirror assembly) relative to an unclaimed article (e.g. wing window) is vague and indefinite. (answer, pages 3-4).

The examiner's reasoning as quoted <u>supra</u> is untenable.

Merely reciting that the area of the mounting plate is larger

than some other element, namely a wing window, does not require the window to be a positive element of the claimed combination in order to satisfy the requirements in the second paragraph of § 112. It is sufficient that one of ordinary skill in the art would understand this claim limitation to mean that the area of the mounting plate is larger than the area of some appropriately sized window which is not regarded as part of the claimed combination. Claim 12 therefore defines the metes and bounds of the claimed invention with a reasonable degree of precision to satisfy the requirements in the second paragraph of § 112. See In re Venezia, 530 F.2d 956, 958, 189 USPO 149, 151 (CCPA 1976).

For the foregoing reasons, we cannot sustain the rejection

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of claim 12 under the second paragraph of § 112. We also cannot sustain any of the other rejections of the appealed claims.

With regard to the § 102(b) rejection, the cited Schuplin patent discloses a pipe hanger which is described as being secured by nails to a wooden joist. Schuplin's hanger does have a slot 16, permitting one clamping portion to be flexed to an opened position relative to another clamping portion to permit a pipe to be inserted in a circular aperture defined by the two clamping portions. However, the opposed hanger surfaces defining slot 16 are straight, not curvilinear as required by claim 1.

Furthermore, Schuplin does not contain a disclosure that a mounting surface of the hanger abuts a portion of a vehicle about the wing window opening of the vehicle door as required by claim 1. In addition, the flexure of Schuplin's hanger does not require one clamping portion to be hinged to the other clamping portion as required by claim 1.

Since Schuplin does not expressly or inherently disclose each and every element of the invention defined in claim 1, it follows that the Schuplin patent is not a proper anticipatory reference for the subject matter of claim 1 and also for claims 2

through 7, which depend directly or indirectly from claim 1. <u>See Kloster Speedsteel AB v. Crucible Inc.</u>, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) (The absence from the reference of any element of a claim negates anticipation of that claim by the applied reference).

With regard to claim 12, Schuplin does not expressly or inherently disclose a living hinge for interconnecting the clamping portions or the location of his joist inside a vehicle passenger compartment even if the joist is construed as being a "mounting plate." As a result, Schuplin also is not a proper anticipatory reference for the subject matter of claim 12. <u>Id</u>.

For the foregoing reasons, the § 102(b) rejection of claims 1 through 7 and 12 is not sustainable.

With regard to the § 103 rejection of claim 8, the cited prior art contains no suggestion that would have led one of ordinary skill in the art to replace Schmidt's mirror-mounting fender bracket with Schuplin's pipe hanger. Even if it is assumed arguendo that there is such a suggestion, the result would not meet all of the terms of the claim for reasons discussed <u>supra</u>. For these reasons, the rejection of claim 8 also

is not sustainable.

The § 103 rejection of dependent claim 9 also is not sustainable because neither Seckerson nor Williams rectifies the deficiencies of Schuplin discussed <u>supra</u>.

Under the provisions of 37 CFR 1.196(b), the following new ground of rejection is entered against claims 8 and 9:

Claims 8 and 9 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

As noted <u>supra</u>, it is well established patent law that the claims must define the metes and bounds of the invention with a reasonable degree of precision. <u>In re Venezia</u>, 530 F.2d at 958,

189 USPQ at 151. It is also well settled that the claim language cannot be read in a vacuum, but instead, must be read in light of the specification without generating confusion. <u>In re Hammack</u>, 427 F.2d 1384, 1391, 166 USPQ 209, 215 (CCPA 1970).

Claim 8 recites that the support (i.e., the mirror support rod) is deployed in the slot which is formed between the "accurate" (i.e., arcuate) surfaces of the claimed first and

second portions of the base member. In contrast, the specification states on page 7 that the mirror support rod 26 is received in the bore 68, not in the slot between the curved or arcuate wall surfaces 30 and 50. According to appellants' specification, therefore, the support rod is not received in a "slot" of any kind. Thus, while the claim language may off hand seem clear in the abstract, the recitation that the support rod is deployed in the claimed slot generates confusion when read in light of the specification, thus rendering claim 8 indefinite.

Claim 9 is indefinite because there is no antecedent basis for the "means for joining," "the first portion," "the second portion" and each recitation of the "T-channel." It is noted that claim 9 is recited to be dependent from claim 7, not claim 8.

The examiner's decision rejecting the appealed claims is reversed, and a new ground of rejection has been entered against claims 8 and 9 pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to

37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off.

Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, <u>WITHIN</u>

<u>TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under  $\S 1.197(b)$  by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR  $\S 1.136(a)$ .

## Reversed/196(b)

IAN A. CALVERT Administrative Patent Judge	) ) )
HARRISON E. McCANDLISH Senior Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES )
CHARLES E. FRANKFORT Administrative Patent Judge	) ) )

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